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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,128	11/20/2006	Takashi Nakamura	S004-5842 (PCT)	4058
7590 Bruce L. Adams Adams & Wilks 17 Battery Place-Suite 1231 New York, NY 10004			EXAMINER MALLARI, PATRICIA C	
			ART UNIT 3735	PAPER NUMBER
			MAIL DATE 03/16/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,128

Applicant(s)

NAKAMURA ET AL

Examiner

PATRICIA C. MALLARI

Art Unit

3735

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9-11 and 15-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4-7,9,16 and 21-25 is/are allowed.
- 6) ☒ Claim(s) 10,11,15,17-20 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is a non-final Office action. New grounds of rejection are presented which were not necessitated by applicants' amendments. See below for details.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 10 recites "organism information detecting means that comes into contact with a subject". The human body, or subject, is non-statutory subject matter and cannot be claimed positively. This rejection may be overcome by replacing the cited language with "organism information detecting means that is configured to come into contact with a subject".

Claims 11, 15, 17, 18, and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based upon consideration of all of the relevant factors with respect to the claim as a whole, claim 11 is held to claim an abstract idea, and is therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below:

There is insufficient recitation of a machine or transformation. Although a machine is recited in the first step of the method of claim 11 and in the preambles of claims 17 and 18, it is only tangentially related to the method, being used in a data

gathering step. No other step inherently requires the use of a machine. Furthermore, no physical transformation is recited.

Similarly, with respect to claim 15, there is insufficient recitation of a machine or transformation. The first step of the method of claim 15 describes how the organism information detecting apparatus functions but fails to require that the apparatus executes those steps in the method. As such, the organism information detecting apparatus is only tangentially related to the method, since the claim merely requires that information be communicated to such an apparatus, and such data communication is merely data outputting.

This rejection may be overcome by positively reciting the machine or apparatus used in a significant step (i.e. not a data gathering or data outputting step) of each of claimed methods.

Claims 19 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The preamble of each of claims 19 and 20 recites "A computer program product having instructions for causing a computer to realize", wherein it is not clear that the "product," as claimed, is a tangible medium, such that the broadest reasonable interpretation would be that the claim includes the software only, wherein the software is non-tangible media. Therefore, the claims are directed to non-statutory subject matter. This rejection may be overcome by replacing "A computer program product having instructions for causing a computer to realize" with "A computer readable medium having embodied thereon computer readable instructions which, when executed by a computer, causes the computer to realize".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 10, 17, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recite "server for communicating information with an organism information detecting apparatus . . ." and later recites the "server executing a previously determined processing operation to the information received from the organism information detecting apparatus". It appears that the latter recitation refers to the information referred to in the former recitation. However, the former recitation fails to positively claim that the information is sent and received. It merely states that the server is *for* communication information with an organism information detecting apparatus. Therefore, it is unclear whether the information is indeed sent by the server and received by the apparatus or whether the server is merely for communication information to the apparatus. Applicants should clarify. Claim 10 contains similar language and, therefore, suffers from the same problem.

Claim 17 recites "an organism signal during a previously determined sampling time period outputted by the organism information detecting means". It is unclear whether the organism signal, the sampling time period, or both are outputted by the

detecting means. Applicants should clarify. Claim 18 contains similar language and, therefore, suffers from the same problem.

Allowable Subject Matter

Claims 1, 4-7, 9, 16, and 21-25 are allowed.

Claim 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, and under 35 U.S.C. 101 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 10, 11, 15, 17-20, and 26 are rejected under 35 U.S.C. 101 and/or 35 U.S.C. 112, 2nd paragraph, and, therefore, are not allowable at this time. However, the prior art of record fails to teach the inventions claimed therein, as described below.

The following is a statement of reasons for the indication of allowable subject matter: The primary reason for the indication of allowable subject matter is the inclusion of the motion state being determined based on whether the supplementary data, which is an average value of the amount of variation per time of data obtained by digitizing the organism signal, exceeds a threshold, in combination with all of the other limitations of the claims, which is not taught or fairly suggested by the prior art of record. While Aoshima teaches comparing an average value $((N+N')/2)$ to a threshold (see col. 8, lines 62-67 of Aoshima) to determine a motion state, this is not an average value of the variation amount per time of the digital data, since N and N' are baseline spectra and are not a variation amount per time of the digital data.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICIA C. MALLARI whose telephone number is (571)272-4729. The examiner can normally be reached on Monday-Friday 9:30 am-5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patricia C. Mallari/
Primary Examiner, Art Unit 3735